

ESTTA Tracking number: **ESTTA154765**

Filing date: **08/03/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91178149
Party	Defendant Reps Design
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Date	08/03/2007
Attachments	91178149Answer.pdf ( 14 pages )(1218366 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of U.S. Application Serial No. 77/003,861  
For: STEPTREK  
Filed: September 21, 2006  
Date of Publication: June 5, 2007

TREK BICYCLE CORPORATION

Opposer,

v.

REPS DESIGN

Applicant.

**FORM OF ANSWER TO OPPOSITION**

In the matter of U.S. Trademark Application Serial No. 77/003,861 ("Serial No. 77/003,861") for the mark "STEPTREK" in International Class 9, filed in the name of Reps Design ("applicant"), which was published for opposition in the Official Gazette of June 5, 2007.

IN REGARD TO CLAIM THAT APPLICANT'S MARK "STEPTREK" SO RESEMBLES TREK'S "TREK" MARK AND TRADE NAME THAT IS LIKELY TO CAUSE CONFUSION OR TO CAUSE MISTAKE OR TO DECEIVE WITHIN THE MEANING OF SECTION 2(D) OF THE TRADEMARK (LANHAM) ACT OF 1946, 15 U.S.C. 1052(d); AND MORE LIKELY TO CAUSE CONFUSION IN, OR TO CAUSE MISTAKE BY, OR TO DECEIVE THE TRADE AND PURCHASING PUBLIC INTO BELIEVING THAT THE GOODS IN SERIAL NO. 77/003, 861 ORIGINATE WITH TREK OR OTHERWISE ARE AUTHORIZED, LICENSED OR SPONSORED BY TREK.

Reps Design, a Minnesota Partnership with its principal place of business at 20020 Swallow Street NW, Cedar, Minnesota 55011, and Michael Reps and

Margot Reps as the applicants for Registration of the above Mark, refute these claims as unsubstantiated based on information contained herein. We do not contest that within the specific niche of the bicycling community, "Trek" may be a familiar mark in relation to bicycles, bicycle parts, and bicycle accessories. However, the application for the mark "STEPTREK" and the goods and services provided under this mark, namely pedometers and step counters, are so dissimilar in meaning, appearance, connotation, public impression, customer base, and other relevant factors in relation to the Opposer's "Trek" mark that the likelihood of confusion is improbable and highly unlikely. As basis, Steptrek hereby gives notice that the following are the grounds on which we rely as supporting our application:

**ORIGIN OF THE MARK STEPTREK AND DEFINITION:**

1. In creation of the "STEPTREK" mark, an entirely new and original mark was created utilizing two existing dictionary words. The word "step" was chosen because pedometers are specifically designed to count steps, and many walking programs are variously referred to as "step programs". "Step" is paired with the word "trek" because common dictionary definitions of the word "trek" include a) to make a slow or arduous journey; b) to journey on foot; 3) To travel by ox wagon (South African). all three meanings refer to "journey" or "travel", which is the most familiar and common definition of the word to the public at large. Joined together, the two words form a pseudo name, one not found in any dictionary.

**UNIQUE QUALITIES OF THE STEPTREK MARK:**

2. This pseudo name is a mark consisting of several unique features to distinguish it in impression and connotation: a) The name "Steptrek" is original and heretofore not used to sell pedometers or other goods or services; b) The name "Steptrek" is not known to be under past or current copyright trademark protection in the United States. c) The name "Steptrek" distinguishes the pedometer wholesaler from other companies and in particular other pedometer

wholesalers; d) The name "Steptrek", although not a dictionary word or previously familiar word, has a distinct descriptive quality which connotes an impression that the company bearing the "Steptrek" mark has goods or services relating to stepping, and by extension, walking.

#### **STEPTREK IN THE SPOKEN FORM**

3. In spoken form, regarding the word "STEPTREK", emphasis is placed on the BEGINNING of the word, the first syllable, "step", which is the dominant portion of the word, and therefore dominates in the perceived meaning of the word. This helps distinguish the mark in its unique name.

#### **DESCRIPTION OF TREK'S TRADEMARKS**

4. There are several examples of "Marks Cited by Opposer as Basis for Opposition". Of those listed, only one example ENDS with the word "Trek" ("E-trek"). All other examples BEGIN with the word "Trek", FOLLOWED by second title name, or a suffix. i.e.: "TREKKING"; "TREK 100"; "TREK BMX"; "TREKBIKES.COM"; "TREKLITE"; "TREK TRAVEL"; "TREK UNIVERSITY" In clear contrast, the Steptrek mark is dissimilar by the fact it is always spelled "STEPTREK" beginning with the letters "STEP" as a single word title, with no spaces between letters. The Steptrek mark is also adjoined by the word "pedometer" or phrasing with the word "pedometer" in close proximity to the mark in all instances to clearly identify and distinguish all of our products.

#### **STEPTREK'S GOODS AND HOW PEDOMETERS WORK**

5. Since 2003, Steptrek sells only one category of product: pedometers. The term "pedometer" is commonly interchangeable with the term "step counter". The prefix "ped" (meaning foot) combined with the word "meter" (to measure) is literally the same definition as "step counter". Both are an electronic device which counts the number of steps a person takes while walking. Typically a pendulum is used as a means to detect hip movement. The hip movement causes the pendulum to swing, which is converted to an electric signal which is relayed to a digital display with the purpose of tallying accumulated walking steps.

**FUNCTION OF PEDOMETERS AND STEP COUNTERS**

6. The primary function of all goods called pedometers and step counters is to detect and measure human walking steps. Some pedometers have additional functions, such as measuring distance walked, calories burned, stride adjustment, weight adjustment, and / or other functions. These additional measurements made by multifunction pedometers are calculations made by a computer chip, and are based on the number of steps walked.

**WALKING AND RIDING A BICYCLE ARE TWO DISTINCT AND SEPARATE ACTIVITIES.**

7. Taking the preceeding into consideration, it is a given that walking is an activity; a separate and distinct activity from bicycle use. Someone who is walking is by definition not bicycling; conversely, someone who is bicycling is by definition not walking.

**DESCRIPTION OF TREK BICYCLE GOODS AND SERVICES:**

8. The Opposer, Trek Bicycle Corporation, in it's written Notice of Opposition, paragraph (6), lists goods and services which utilize the trade name "Trek"; namely bicycles, bicycle frames, bicycle parts and accessories... including electronic instruments related to monitoring performance (of bicycles), namely cycling (bicycle) computers and heart monitors. As far as can reasonably be discerned, each and every good and service named by the opposition, are plainly and clearly related to, designed for use with, supplement, and consist of bicycles, bicycle parts, and/or bicycle accessories. With the exception of heart monitors, the goods and services listed by the Opposer are dependent on a bicycle as part of the inherent functionality of their goods and/or services.

**WHEELED VEHICLES HAVE A DIFFERENT MEASURING DEVICE**

9. Wheeled devices, including bicycles, may be outfitted with a type of measuring device accessory. However, these devices measure wheel rotation, which is a completely different system of measurement and not related to walking, the measurement of walking, or the use of pedometers in any way.

Further, a device which measures wheel rotation is secondary and a supplemental to the primary function of the device itself, as in the example of bicycles. Conversely, it is the primary function of a pedometer to tally a total number of human steps taken.

#### **DISSIMILAR USE AND NOT A CAUSE FOR CONFUSION**

10. Since pedometers cannot be used functionally on bicycles, it is unlikely a consumer would associate the "Steptrek" pedometer mark with the "Trek" Bicycle mark. In fact, in the four years Steptrek has been an internet pedometer wholesaler, there has not been a single case where a customer asked about or referred to the Trek Bicycle Corporation, asked about bicycles or bicycle related products or was under any impression Steptrek was in any way connected with bicycles. Both Steptrek and the Trek Bicycle Corporation are businesses who have maintained an internet presence for over four years concurrently on the internet, without evidence of actual confusion. Quite simply, Steptrek customers are looking for step counters and pedometers.

#### **STEPTREK'S SALES PLAN AND MARKETING NICHE**

11. Steptrek step counters and pedometers are sold to large group walking programs, who use them as incentives as part of a plan to typically achieve 10,000 steps in a single day. This has been determined to be an average number of steps a person should take as a means to maintain proper body weight. Steptrek step counters and pedometers are used primarily in disease prevention programs to combat the rapid rise of obesity rates in the population, which have resulted in increased heart disease, diabetes, and a host of other health repercussions.

#### **STEPTREK TARGET MARKET / BUYERS**

12. Steptrek's target market / customer base are walking program coordinators of non-profit organizations, state and county health departments, schools, hospitals, clinics and various walking and wellness programs consisting of

500 or more participants in a single program. In almost all cases, Steptrek pedometers are not re-sold for profit, but given without charge to participants in walking programs. The pedometers are categorized as an "incentive item" for a majority of buyers. As an incentive item, all Steptrek pedometers are customized with an imprint or logo to promote a walking program as specified by individual buyers. Therefore, end users of Steptrek products do not receive pedometers with the Steptrek mark, but instead the mark of the buyer's choosing, i.e. the name of their walking program or other logo. If a customer chooses not to receive a custom imprint, the pedometers are left unimprinted, or left generic, and there is no Steptrek mark used.

#### **DIFFERENT TRADE CHANNELS**

13. Trek Bicycle Corporation, based on information contained within the Notice of Opposition, offers a "wide range of consumer products." In contrast, Steptrek is a wholesale reseller of pedometers and does not sell pedometers or any other products to the general public. Steptrek does not do any retail advertising.

#### **STEPTREK IS AN INTERNET ONLY BUSINESS**

14. Steptrek pedometers are sold as an INTERNET ONLY business. Occasional postal mailings of samples are sent to walking program coordinators upon request, but all inquiries and leads are internet based. Steptrek advertises with major search engines (i.e.: Google, MSN, Yahoo) and the advertising fees can be substantial. Search engines charge a fee based on a "pay per click" system. This means Steptrek pays a fee to a search engine each time the steptrek.com web site is visited. It is in the best interest of Steptrek, and the most economical, to only attract interested customers to the Steptrek web site, customers with a specific interest in not just pedometers, but pedometers in bulk, since Steptrek has a 500 piece minimum purchase, as stated previously. Irrelevant clicks, such as someone wishing to purchase a single pedometer,

would not be beneficial to Steptrek, and in fact would be economically detrimental. A web site visitor would not be able to purchase from Steptrek and leave, but Steptrek would still be charged for that visit. For the same economic reasons, Steptrek would not want a customer looking for bicycles or bicycle accessories to visit the Steptrek site. In fact, it is in Steptrek's best interest to avoid any comparison or confusion with non-pedometer products for simple economic reasons. Steptrek does not know the extent to which Trek Bicycle Corporation relies on internet sales; however, it is noted, unlike Steptrek, Trek Bicycle Corporation does not sell product directly at their online presence.

#### **STEPTREK TARGET MARKET AND ONLINE ADVERTISING**

15. Steptrek has a very specific, very narrow target market for all of its advertising. The Steptrek target market is predominantly female 30-55 year old professionals, in specialized program coordinator positions within non-profit or for-profit corporations, who utilize online search engines to search for bulk pedometers. This target market specifically uses search terms such as "bulk pedometers", "step program pedometers", "step counters in quantity", etc. Keywords like these illustrate the majority of customer searches who reach Steptrek's online web site. This has been Steptrek's target market and focus for advertising since its inception in 2003.

#### **SUBHEAD PHRASING FOR FURTHER CLARIFYING THE STEPTREK NAME**

16. In all manners of advertising, primarily consisting of online search engines, Steptrek clearly advertises using the subhead phrasing "Wholesale Pedometers for Group Walking Programs" or "Wholesale Factory Direct Pedometers for Group Walking Programs and Events" in all descriptive phrasing to further refine and narrow the target audience for optimal customer visits. This same phrasing also appears on every one of the Steptrek web pages online. The focus on each and every web page concerns the activity of walking and



measuring steps at it's core. There are no mentions of bicycles, bicycle accessories, or bicycle related items anywhere on the Steptrek web site. The Trek Bicycle Corporation, on their online web site, also uses the subhead "Welcome to Trekbikes", a clear implication the focus is on bicycles. Further indication of this is their web address, "www2.trekbikes.com".

**DIFFERENT GOODS, DIFFERENT VARIETY OF GOODS**

17. Steptrek sells only pedometers under the Steptrek name. Steptrek does not sell nor intends to register or sell bicycles or bicycle related products or services offered by the Trek Bicycle Corporation, nor does Steptrek dispute the right of Trek Bicycle Corporation to offer those products or services listed as registered in the Opposition, including " bicycles and bicycle frames", "ride support vehicles in competitive and recreational events; namely, bicycle tours, bicycle races, and triathlons"; "cycling computers, water bottles, water bottle cages, exercise equipment, head protective helmets"; "bicycles, bicycle frames, and bicycle structural parts", "educational services, namely, providing seminars and clinics relating to the use of exercise equipment", "online retail and wholesale store services, all provided via the internet", "non-alcoholic beverages and non carbonated drinking waters", "clothing and padded gloves", "orienteering equipment and clothing for outdoor sporting activities, namely protective outer wear", "arranging travel tours featuring hiking, river rafting, whale watching, kayaking, and bicycling; cultural tours, namely, guided tours of wineries, and services for providing food and drinks and temporary lodging for those participating in bicycling activities and cultural activities related to bicycling, namely hiking, river rafting, cultural tours, wine tastings, whale watching and kayaking", "instructional and training services in the field of retailing bicycles, bicycle clothing and bicycle accessories, and in the fields of bicycle safety, bicycle recreation, bicycle service and bicycle repair", " backpacks, fanny

packs, textile tote bags, hip packs, messenger bags, rack trunks, saddle bags, bicycle seat packs, and all-purpose sport bags"... or "off-road all-terrain utility vehicles".

None of those products or services listed by Trek Bicycle Corporation refer to the product of pedometers or step counters. As stated, the above items and services are not related in any way to the use of pedometers to count walking steps.

**OTHER MARKS UTILIZING THE WORD "TREK" IN THEIR NAME**

18. In the Opposition, the Trek Bicycle Corporation states in Paragraph 9, "The public has come to associate Trek with the "TREK" trademark and trade name." As stated previously, we do not dispute that within a narrow segment of the community, the name "TREK" may be a term familiar in relation to bicycles. But in the opinion of Steptrek, and based on internet searches, it is unlikely the public in general recognizes nor associates the word primarily with bicycles. Those who do not participate in the activity of bicycling will be more likely to interpret the word as defined in the broad sense of being a "journey", especially when combined with other words in a mark. Utilizing an online search such as Google, a search for the term "Trek" returns over 54 million results. The same search engine returns 80,800 web sites which implement the term "trek.com" as part of the title in their URL addresses on the internet. The term "Trek" is utilized before or after other words in the marks of goods and services ranging from travel agencies ("Global Trek") to boating rentals ("Sea Trek", "Kayak Trek", "Wave Trek"); outdoor clothing lines ("Field & Trek"); to Land Rover and off road products ("Trek Outfitters"); and many, many other examples. Based on the sheer volume of products and services where the word "trek" is utilized as part of a descriptive mark, it is plain and apparent the public in general associates "Trek" in the broader

sense of describing a "journey". A Google search for the term "trek.com" returns with these top 50 web sites:

Google Search Results 1 - 50 of about 80,800 for "trek.com".

1. [www.trek.com/](http://www.trek.com/)
2. [www.trekbikes.com/](http://www.trekbikes.com/)
3. [www.startrek.com/](http://www.startrek.com/)
4. [www.vintage-trek.com/](http://www.vintage-trek.com/)
5. [www.w-trek.com/](http://www.w-trek.com/)
6. [www.tech-trek.com/](http://www.tech-trek.com/)
7. [www.trek-online.com/](http://www.trek-online.com/)
8. [www.mi-trek.com/](http://www.mi-trek.com/)
9. [www.earth-trek.com.hk/](http://www.earth-trek.com.hk/)
10. [www.nepal-trek.com/](http://www.nepal-trek.com/)
11. [www.sea-trek.com/](http://www.sea-trek.com/)
12. [www.info-trek.com/](http://www.info-trek.com/)
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17. [www.fil-trek.com/](http://www.fil-trek.com/)
18. [www.nu-trek.com/](http://www.nu-trek.com/)
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32. [www.trek.com.au/](http://www.trek.com.au/)
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35. [www.extremetrek.com/](http://www.extremetrek.com/)
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37. [www.x-trek.com/](http://www.x-trek.com/)
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#### **DIFFERENCES IN LOGO STYLE AND DESIGN**

19. The Steptrek logo was designed independently and on its own merits, free from outside influence on the design. It was not created to look like the Trek Bicycle Corporation's logo, nor does it resemble the Trek Bicycle Corporation's logo. The Opposer's logo uses a font with serifs. The Steptrek logo font does not have serifs. The Opposer's logo uses a font that is wider than it is tall. The Steptrek logo is taller than it is wide. The Opposer's logo consists of vertical line and weight strokes 3-4 times wider than the horizontal strokes. The Steptrek logo maintains a consistent thickness of line and weight on both vertical and horizontal stroke. Also, the logo colors are different. The Opposer's logo is white on a red field. The Steptrek logo is royal blue on a white field. As stated previously, the Steptrek logo is also dissimilar in that the wording begins with different letters than the "TREK" logo, namely the letters "STEP". These letters visually change the look of the letters that follow. The differences in fonts, colors, style and design are so dissimilar the likelihood of confusion or comparison to the "TREK" logo is unlikely. Furthermore, there is no intention to deceive or misrepresent in any manner or fashion.

#### **ADMISSION OF SIMILARITIES IN GOODS AND SERVICES**

20. Steptrek admits the following allegations in the notice of Opposition:  
a) Upon information provided in the Opposition, Trek Bicycle Corporation offers for sale a model of heart monitor. Heart monitors, variously called pulse counters, are devices designed to count the beating of the human heart. Steptrek does sell one pedometer model, which in addition to its step counting capability,

also counts the pulse of the user, in effect a simple form of heart monitoring device. A second model offered by Steptrek counts the pulse of the user with no additional functions. As devices which are designed to count a person's pulse, heart monitors and pulse counters are utilized in relation to a variety of physical activities, from walking to running, biking to exercising and playing sports. A multifunction pedometer with a built-in pulse counter is a natural and logical line extension for Steptrek, and is therefore in their product line. Steptrek believes offering heart monitors or pulse counting devices are not in any way detrimental or damaging, or likely to be confused with similar item(s) from the Trek Bicycle Corporation.

b) Steptrek has variously used the mark "Steptrek" and "StepTrek" interchangeably, the difference being the fifth letter "T" capitalized in some instances, but not always. This inconsistency is entirely unintentional and not meant to confuse or deceive, but merely an error of inconsistency. Previous to receiving the Notice of Opposition dated June 5, 2007, Steptrek was unaware of the existence of Trek Bicycle Corporation and their trademarked "Trek" name. Steptrek believes the two marks are dissimilar because of the aforementioned reasons; however, Steptrek will be willing to concede the capitalization of the fifth letter "T" in "StepTrek" incorrectly adds emphasis to the second half of the mark. As such, Steptrek would be willing in good faith follow a self-imposed policy which mandates the reproduction of the mark in one of two ways: with an lowercase "t", namely "Steptrek"; and in the case of all capitalized letters, Steptrek would spell the mark as "STEPTREK".

#### **CONCLUSION - NO INTENT TO DECEIVE OR CONFUSE**

21. By reason of the foregoing, Steptrek believes the opposition to the application of trademark for the mark "STEPTREK", and claims of damage by registration of the mark by Reps Design, are unfounded and groundless. Steptrek

Applicant's Answers in regard to Opposition Against "STEPTREK"  
Serial No. 77/003,861

has no intent to deceive or cause confusion in, or to cause mistake by, or to deceive the trade and purchasing public in any way. Steptrek is proud to be a partner in the fight against obesity, and strives to maintain ethical business standards in all business practices. Reps Design, the parent company of Steptrek, is in good standing with the Better Business Bureau since 1983 and has never been the subject of any complaints. It is Steptrek's goal to become a preeminent wholesaler of pedometers and related goods for group walking programs across the country.



**REINSTATEMENT REQUEST**

22. Furthermore, as The U.S. Patent and Trademark Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02, Steptrek believes the application for the mark "STEPTREK" should be reinstated.

Respectfully submitted

STEPTREK.COM PEDOMETERS

Date: August 3, 2007

By:   


Submitted by the Owners,  
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pedometers@steptrek.com

The home page of Steptrek.com, Applicant; and the home page of Trek Bicycle Corporation, Opposer.


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Right now, tens of thousands of people are taking steps toward healthier lives with STEPTREK pedometers. From basic step counters to multifunction models, you'll find a reliable pedometer to fit your budget.



The StepTrek INSTANT REPLACEMENT GUARANTEE means you'll always have the pedometer you need for your program or event. Customers appreciate our full service and friendly support staff. SIMPLE PRICING CHARTS make it easy to figure out your total price.



Did you know? Not all advertised pedometers are really new! Click here to learn more.

[Learn more](#)

Compare features on various models. Click here.

[Compare](#)

Questions? Give us a call at 1-866-533-TREK, or e-mail us by clicking here.

[Ask Us](#)

Send in your photo and you could win FREE pedometer! Click here to learn more.

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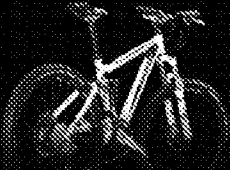



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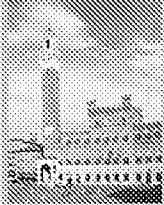
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**SUSPEND CONVENTIONAL THOUGHT.**





**Dominion**  
Congratulations to Alberto Contador, Levi Leipheimer, and the entire Discovery Channel Pro Cycling Team on their amazing performance at...



**Italy, Tuscany Classic**  
Join us in a region known for its rich artistic history, slowly-released culinary traditions and an unyielding passion for cycling. Southern Tuscany...

**Trek News**

- 6-01-07 Extraordinary National 24 Hour Solo Championships
- 7-30-07 Discovery Channel Dominates Tour
- 6-27-07 Discovery Channel Announces TdF Roster
- 6-27-07 Ben Coster Talks Tech With The Madone
- 6-22-07 First Win on the New Madone